

**Notice of Allowability****Application No.**

09/803,702

**Examiner**

Taylor Victor Oh

**Applicant(s)**

QIU ET AL.

**Art Unit**

1625

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 5/19/2004.
2. ☒ The allowed claim(s) is/are 1-29.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date 5/20/04.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_.

Examiner's Amendment and Reasons for Allowance

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with an attorney of record, Mr. Kent s. Kokko on 5/20/2004. During the interview, the Examiner has decided to rejoin the claims 20-29 to claims 1-19 for allowance.

**The Status of Claims**

Claims 1-29 are pending.

Claims 1-29 have been allowed.

**2. The application has been amended as follows:**

In claims 1, 2, and 4 on page 2 (amendment dated on 5/19/2004),

In claim 1, line 7, the term "--comprising--" after the phrase "one or more monofunctional fluorine-containing compounds comprising " should be changed to "having".

In claim 2, at the end of line 2, the term "--comprising--" after the phrase "one or more water-solubilizing compounds" should be changed to "having".

In claim 4, at the end of line 2, the term "--comprising--" after the phrase "one or more polymerizable compounds" should be changed to "having".

3. The following is an examiner's statement of reasons for allowance:

- the rejection of claims 1-2, 4, 8-10 under 35 U.S.C. 112, second paragraph, has been withdrawn due to applicants' convincing argument;
- the rejection of Claims 1-4, and 10 under 35 U.S.C. 102(b) as being anticipated clearly by Smith et al (WO 93/01349) has been withdrawn due to applicants' convincing argument.

This invention relates to fluorochemical urethane compositions comprising one or more compounds or oligomers having at least one fluorine-containing repeatable unit and at least one fluorine-containing terminal group. This invention also relates to articles comprising a substrate and the fluorochemical composition, which may be applied as coatings or incorporated as melt additives the fluorochemical compositions impart oil and water repellency to the substrate. In other aspects, this invention relates to processes for imparting oil and water repellency characteristics to substrates and articles.

The closest prior art to the current invention is Smith et al (WO 93/01349).

Smith et al (WO 93/01349) discloses fluorochemical compositions comprise a fluorinated acrylate monomer, polyalkylene glycol acrylate, a polyalkoxylated polyurethane having pendant perfluoroalkyl groups containing polyisocyanates, and a fluorinated monoalcohol, and etc.

Art Unit: 1625

However, the instant invention differs from the prior art reference in that the claimed fluorinated polyols are not in the prior art. In addition, unless all limitations of the claims are met, there is no prior art rejection. See In re Zurko 59 USPQ 2d 1690 (Fed Cir. 1991) and In re Lee, 61 USPQ 1430 (Fed Cir. 1991).

Therefore, applicants' subject matter would not have been obvious to the skilled artisan in the art.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning the communication after allowance such as sending all post-allowance correspondence should be directed to "Box Issue Fee" or faxed directly to PUBS at 703-305-8755. This will expedite the process of these papers.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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5/28/04

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